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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,094	01/17/2007	Jeffrey Blyth	GJE-7543	5601
23557 7590 09/18/2009 SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION PO Box 142950 GAINESVILLE, FL 32614				
EXAMINER CALLAWAY, JADE R				
ART UNIT 2872		PAPER NUMBER		
NOTIFICATION DATE 09/18/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

euspto@slspatents.com

Office Action Summary

Application No.

10/565,094

Applicant(s)

BLYTH ET AL.

Examiner

JADE R. CALLAWAY

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/31/09 has been entered.

Response to Amendment

2. The amendments to the claims, in the submission dated 7/31/09, are acknowledged and accepted.

Response to Arguments

3. Applicant's arguments filed 7/31/09 have been fully considered but they are not persuasive. Applicants argue that it would not "have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Lowe et al., as taught by Stephens et al., in order to guide light with the narrowest possible bandwidth to the surface so that the colors reflected are indicative of the part of the reflector from which it is received." The Examiner respectfully disagrees. The optical fibers (3-8) of Stephens et al. each direct a very narrow band width of light to the holographic reflecting surface 2. The wavelengths reflected are arranged to be mutually exclusive so that the color is indicative of the part of the reflector from which it was received. The reflected light is received by optical fibers (9-14) and then combined for

transmission with a single optical light path 15. Stephens et al. specifically disclose that a reflection does occur; even light with a narrowest possible band width. As such, a person having ordinary skill in the art would have been motivated to modify the device of Lowe et al., in view of Stephens et al., so that light can be guided with a very narrow band width to the holographic surface so that the colors reflected are indicative of the part of the reflector from which it is received.

Applicants argue that in the invention the optical fibers guide white light (i.e. a broad band of wavelengths) to the surface as opposed to using monochromatic light as disclosed in the prior art. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., using white light) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants also argue that the configuration of the subject invention can be different from the configuration of Stephens et al. The Examiner notes that the claims were rejected under 35 U.S.C. 103 and not 35 U.S.C. 102 and that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The prior art devices need not be individually identical to the subject invention, wherein the differing features are not relied upon in the claims. Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants further argue that in contrast to Stephens et al. the configuration of the subject invention "provides significant advantages because any wavelength satisfying the Bragg condition in the hologram is reflected back onto the receiving fiber, independent of orientation." Applicants also argue that an analyte can be detected in an environment where there is "considerable light scatter." The Examiner respectfully notes that the features upon which applicant relies (i.e., that any wavelength satisfying the Bragg condition is reflected and that the analyte is detected where there is considerable light scatter) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-6 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe et al. (5,989,923) and Stephens et al. (GB 2054995 A) of record.

Consider claim 1, Lowe et al. disclose (e.g. figure 1a) an apparatus for detecting an analyte, comprising: a sensor (9, sensor) comprising a medium (10, support medium) and, disposed therein, a hologram (17, hologram) wherein an optical characteristic of the hologram changes as a result of a variation of a physical property of the medium resulting from interaction with the analyte, and wherein the hologram is formed as a non-planar mirror (reflection hologram with fringes that can be flat or curved) [col. 4, lines 32-39, col. 10, lines 4-39]. However Lowe et al. do not disclose a unit of optical fibers for transmitting light to and from the hologram. Lowe et al. and Stephens et al. are related as devices comprising holograms. Stephens et al. teach (e.g. figures 1-3) a unit of optical fibers (3-14, optical fibers) for transmitting light to and from a hologram (17, reflecting surface) [pg. 2, lines 42-103]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Lowe et al., as taught by Stephens et al., in order to guide light with the narrowest possible bandwidth to the holographic surface so that the colors reflected are indicative of the part of the reflector from which it is received.

Consider claim 2, the modified Lowe et al. reference discloses (e.g. figure 4 of Stephens et al.) an apparatus wherein the hologram is formed as a concave mirror [pg. 3, lines 18-22].

Consider claim 4, the modified Lowe et al. do not disclose that the hologram is formed as a corner cube prism. Note that the Court has held that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination,

see **In re Dailey**, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). All mirrors, whether they be concave, convex or cube-corner shaped, are capable of effecting retroreflection. Further, one would have been motivated to have the hologram be formed as a corner cube prism in order to reduce scattering of light during reflection

Consider claim 5-6, Lowe et al. disclose (e.g. figure 1a) a method for the production of an apparatus comprising a sensor (9, sensor) comprising a medium (10, support medium) and, disposed therein, a hologram (17, hologram), wherein an optical characteristic of the hologram changes as a result of a variation of a physical property of the medium resulting from interaction with the analyte, and wherein the hologram is formed as a non-planar mirror (reflection hologram with fringes that can be flat or curved); wherein the method comprises forming, in a non-planar medium (can be flat or curved), a hologram, as a non-planar mirror (reflection hologram with fringes that can be flat or curved), that is recorded using a planar mirror [col. 4, lines 32-39, col. 10, lines 4-39]. However Lowe et al. do not disclose that the apparatus comprises a unit of optical fibers. Lowe et al. and Stephens et al. are related as devices comprising holograms. Stephens et al. teach (e.g. figures 1-3) an apparatus comprising a unit of optical fibers (3-14, optical fibers) [pg. 2, lines 42-103]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Lowe et al., as taught by Stephens et al., in order to guide light with the narrowest possible bandwidth to the holographic surface so that the colors reflected are indicative of the part of the reflector from which it is received.

Consider claim 14, Lowe et al. disclose (e.g. figure 1a) a method for the detection of an analyte, which comprises remotely interrogating, with light, the holographic element of a sensor (9, sensor) comprising a medium (10, support medium) and, disposed therein, a hologram (17, hologram), wherein an optical characteristic of the hologram changes as a result of a variation of a physical property of the medium resulting from interaction with the analyte, and wherein the hologram is formed as a non-planar mirror (reflection hologram with fringes that can be flat or curved); wherein the method further comprises detecting any change in an optical characteristic of the sensor [col. 4, lines 32-39, col. 10, lines 4-39]. However Lowe et al. do not disclose that the interrogating is via a unit of optical fibers that transmits the light to and from the hologram. Lowe et al. and Stephens et al. are related as devices comprising holograms. Stephens et al. teach (e.g. figures 1-3) interrogating via a unit of optical fibers (3-14, optical fibers) that transmits the light to and from a hologram (17, reflecting surface) [pg. 2, lines 42-103]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Lowe et al., as taught by Stephens et al., in order to guide light with the narrowest possible bandwidth to the holographic surface so that the colors reflected are indicative of the part of the reflector from which it is received.

Consider claim 15, Lowe et al. teach (e.g. figure 1a) a method wherein the light source is collimated (12, laser light rays from a laser source) [col. 10, lines 4-14].

6. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe et al. (5,989,923) in view of Stephens et al. (GB 2065995 A) as applied to claims 1, 5 and 14-15 above, and further in view of Yin et al. (5,499,117).

Consider claims 16-19, the modified Lowe et al. reference discloses a recording surface that is formed as a non-planar mirror. However, the modified Lowe et al. reference does not disclose that the recording surface is a non-planar surface. Lowe et al., Stephens et al. and Yin et al., are related as devices utilizing holograms. Yin et al. teach a recording surface formed as a non-planar surface [col. 2, lines 7-40]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of the modified Lowe et al. reference, as taught by Yin et al., in order to have a curved surface without distorting the optical properties of the hologram layer.

7. Claims 3 and 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe et al. (5,989,923) in view of Stephens et al. (GB 2065995 A) as applied to claims 1 and 5 above, and further in view of Mizutani et al. (6,483,611) of record.

Consider claim 3, Lowe et al. do not disclose a sensor wherein the hologram is formed as a convex mirror. Lowe et al., Stephens et al. and Mizutani et al. are related as devices utilizing holograms. Mizutani et al. teach (e.g. figure 1-2) a sensor wherein the hologram is formed as a convex mirror [col. 1, lines 59-67, col. 2, lines 7-9, 65-68, col. 3, lines 1-11 and col. 15, lines 26-53]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Lowe

et al., as taught by Mizutani et al., in order to allow for magnification or reduction of an image formed from the hologram element.

Consider claims 7-10, the modified Lowe et al. do not specifically disclose a sensor wherein the hologram is formed using a planar, non-planar, concave mirror or a mirror capable of effecting retroreflection. Lowe et al., Stephens et al. and Mizutani et al. are related as devices utilizing holograms. Mizutani et al. teach (e.g. figure 1-2) a sensor wherein the hologram is formed using a planar, non planer and concave mirrors [col. 1, lines 59-67, col. 2, lines 7-9, 65-68, col. 3, lines 1-11 and col. 15, lines 26-53]. Note that a retro reflector is defined as a device that reflects light back to its source. As such, the mirrors of Mizutani et al. will function as retroreflectors. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Lowe et al., as taught by Mizutani et al., in order to allow for magnification or reduction of an image formed from the hologram element.

Consider claim 11, the modified Lowe et al. reference does not disclose that the hologram is recorded using a corner cube prism. Note that the Court has held that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). All mirrors, whether they be concave, convex or cube-corner shaped, are capable of effecting retroreflection. Further, one would have been motivated to have the hologram be recorded using a corner cube prism in order to reduce scattering of light during reflection.

Consider claim 12, the modified Lowe et al. reference does not disclose that the hologram is recorded using reflective beads. Note that the Court has held that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination, see **In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)**. Further, one would have been motivated to have the hologram be recorded using reflective beads in order to reduce scattering of light during reflection and increase reflective capabilities.

Consider claim 13, the modified Lowe et al. reference discloses (e.g. figure 2 of Mizutani et al.) a method wherein the hologram is recorded using a lens (542, object lens) placed between the light source and the medium [col. 2, lines 19-35 of Mizutani et al.].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JADE R. CALLAWAY whose telephone number is (571)272-8199. The examiner can normally be reached on Monday to Friday 6:00 am - 3:30 pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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